

REMARKS

Reconsideration of the Final Office Action mailed December 6, 2004, (hereinafter "instant Office Action"), and withdrawal of the rejection of claims 1-22 and 38-58, are respectfully requested.

In the instant Office Action, claims 1-60 are listed as pending and claims 1-22 and 38-58 are listed as rejected. Claims 23-27, 59 and 60 are listed as withdrawn from consideration.

In the Advisory Action the Examiner checked off the box that states "The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief.". Applicants respectfully point out that the Reply and Notice of Appeal were filed concurrently on March 7, 2005.

Applicants have removed the markings that inadvertently remained in Claim 1 after the amendment to claim 1 in the Reply filed September 22, 2004. Applicants have also changed the status of claims 8 and 16 to "Original". The status of claims 8 and 16 were inadvertently changed to "Currently Amended" although no amendments were made to either claim.

In the Advisory Action mailed April 5, 2005, the Examiner states that "[i]n claim 1, page 6, lines 9-11, the newly added compounds No. 1-2, 4-7 are not found in the original written description." Applicants respectfully disagree. The "newly added compounds" are in fact not additive to claim 1 but instead result in a narrower scope of the original claim and do not result in the inclusion of elements because they are not specifically excluded. No new concepts are raised by the exclusion of specific compounds from claim 1. In fact, the invention is the same as was originally described; Applicants have merely narrowed Claim 1 with this amendment.

The patent law provides for the amendment of claims during prosecution. To exclude specific compounds has been a long accepted practice within the USPTO. Literal support for excluding specific compounds has not previously been required. So long as an applicant conveys that he had possession of the invention at the time of filing he has met the requirements of 35 U.S.C. § 112, first paragraph.

Further, in support of the excluded compounds, Applicants direct the Examiner's attention to *In re Edward*, 568 F 2d 1349, 1351- 1352 (CCPA 1978), which supports Applicants' position that *ipsi verbis* disclosure is not necessary to satisfy the written description requirement

of 35 USC 112, first paragraph, See *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996); *In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978) (asserting that all that is required is that the Application reasonably convey to persons skilled in the art that, as of the filing date, the inventor had possession of the subject matter later claimed by him). Furthermore, inquiry into the question of whether a particular claim complies with the written description requirement of 35 USC 112, first paragraph, is a factual one that must be assessed on a case-by-case basis. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991) (reviewing with approval a line of CCPA cases that stressed the fact specificity of inquiries regarding compliance with the written description requirement of 35 USC 112first paragraph).

Applicants respectfully contend that the excluded compounds added to claim 1 in the Reply filed March 7, 2005 does not undermine the claim's patentability vis-a-vis the written description requirement of 35 USC 112, first paragraph, because the mere lack of literal support for the excluded compounds in the application as filed is insufficient to support the Examiner's rejection. See *In re Edwards*, 568 F.2d 1349, 1354 (CCPA 1978) (holding that the USPTO must also supply reasoning as to why a claim lacking literal support fails to comply with the written description requirement of 35 USC 112, first paragraph).

Furthermore, the Applicants respectfully contend that the application, at the time it was filed, would have reasonably conveyed to one of ordinary skill in the arts of organic and medicinal chemistry that the Applicants were in possession of the subject matter of claim 1 as amended because the amended claim reads on the bulk of the exemplification provided in the application. See *In re Johnson*, 558 F.2d 1008, 1019 (CCPA) (stating "[t]he notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therein, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of [35 USC] 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute"). Additionally, the Applicants respectfully assert that because the application, at the time it was filed, supported claim 1 as originally filed, i.e., prior to its amendment to include the proviso, the application, at the time it was filed, necessarily supports claim 1 as amended. See *In re Johnson*, 558 F.2d 1008, 1019 (CCPA) (holding that "the specification, having described the whole, necessarily described the part remaining").

Applicants' written description clearly conveys that Applicants had possession of the instant invention at the time of filing. One of ordinary skill in the art of medicinal chemistry would understand the written description and claims as filed by Applicants, as well as the amended claims. The application as originally filed provided adequate written description for the claims as originally filed. The excluded compounds inserted by Applicants merely excises a small group of compounds. It does not change the nature of the instant invention. Since a narrower breadth is encompassed by the original claim, and the application as originally filed provided adequate written description for the originally-filed claims, it follows that a claim of narrower scope is necessarily supported. Therefore, the instant specification provides the requisite evidence of possession for amended claim 1.

The Examiner has maintained the rejection of claims 1-22 and 38-58 under 35 U.S.C. §103(a) over Das et al., U.S. 2002/0123484 A1. Applicants respectfully traverse this rejection and maintain the arguments presented in the Replies filed September 22, 2004 and March 7, 2005. In order for an invention to be considered obvious under 35 U.S.C. 103(a), the invention must be considered as a whole, there must be some motivation or suggestion in the prior art reference itself to modify the reference, and there must be a reasonable expectation of success.

Das et al. does not suggest modifications to arrive at Applicants' genus. Without such a suggestion or motivation, Das et al. does not render Applicants' genus obvious. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification", *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir, 1984).

The Examiner has not shown how Das et al. renders obvious Applicants' entire genus. Applicants maintain that Das et al. does not render claims 1-22 and 38-58 obvious.

Based upon the foregoing, the rejection of claims 1-22 and 38-58 under 35 U.S.C. §103(a) over Das et al. is obviated and should be withdrawn.

The Examiner has objected to claims 1-22 and 38-58 as containing non-elected subject matter heteroaryl or heterocycle, i.e. pyridyl, triazole, furanyl, imidazole, morpholino, pyrrolidine, etc. Applicants respectfully decline the Examiner's suggestion to delete such subject

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matter at this time. Upon receiving a Notice of Allowability wherein deletion of non-elected subject matter is the only remaining issue Applicants will delete the non-elected subject matter.

No fees are due for the instant amendment since the total number of claims after entry of the amendments hereinabove is not more than the total number of claims that Applicants have paid for to date.

Based upon the foregoing, Applicants believe that claims 1-22 and 38-58 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that there are any issues that could be resolved in a telephone conference, Applicants invite the Examiner to call Applicants' undersigned agent.

Respectfully submitted,

Date: May 5, 2005

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